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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/141,318	08/27/1998	HIROSHI ISOMURA	1046.1190/J	9722

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STAAS & HALSEY LLP
700 11TH STREET, NW
SUITE 500
WASHINGTON, DC 20001

EXAMINER

ENG, GEORGE

ART UNIT PAPER NUMBER

2643

DATE MAILED: 06/17/2003

17

Please find below and/or attached an Office communication concerning this application or proceeding.

9

Office Action Summary

Application No.

09/141,318

Applicant(s)

ISOMURA, HIROSHI

Examiner

George Eng

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 March 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-9,12-17,20-24,27-31 and 34-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-9,12-17,20-24,27-31 and 34-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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DETAILED ACTION

Response to Amendment

1. This Office action is in response to amendment filed 3/28/2003 (paper no. 16).

Claim Objections

2. Claims 1, 9 and 17 are objected to because of the following informalities: claim 1, line 14, "the status" should be --the state--; claim 9, line 8, "the plurality of terminal devices " should be --a plurality of terminal devices--, and "lines 12-13, "a plurality of terminal devices" should be --the plurality of terminal devices--; and claim 17, line 8, "the plurality of terminal devices " should be --a plurality of terminal devices--, and line 12-13, "a plurality of terminal devices" should be --the plurality of terminal devices--. Appropriate correction is required.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 3-9, 12-17, 20-24, 27-31 and 34-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hsiao (US PAT. 5,848,137) in view of Horiuchi et al. (US PAT. 6,272,530 hereinafter Horiuchi).

Regarding claim 1, Hsiao discloses a telephone with an electronic mail managing function capable of connecting with at least a mail server and a computer as shown in figure 1 comprising access means (34) for accessing to the mail server (col. 4 lines 3-4 and lines 43-45), a mail memory (90) for storing an electronic mail which is sent to one user downloaded from the mail server through the access means (col. 4 lines 5-8), transmission means for transmitting the electronic mail stored in the mail memory to the computer (col. 4 lines 17-19), wherein the electronic mail managing function is provided logically between the mail server and the computer (col. 5 lines 26-35 and col. 7 lines 6-15). Hsiao differs from the claimed invention in not specifically teaching that the telephone with the electronic mail managing function connecting with a plurality of terminal device and having a mail status memory for storing each status of the electronic mail stored in the memory in order to manage the electronic mail based in the status of the electronic mail corresponding to each of the terminal devices. However, Horiuchi teaches transmitter and receiver (101 and 103) for an electronic mail system capable of connecting with a plurality of terminals (figure 1 and col. 2 line 62 through col. 3 line 29) comprising a status memory (405) for storing each status of the electronic mail as shown in figure 7 and a mail managing function integrately managing the electronic mail based on the status of the electronic mail corresponding to each of the terminal (col. 5 lines 12-67). By combining Hsiao with Horiuchi, the electronic mail will retain in the memory if a user hasn't read the mail properly. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Hsiao in having the electronic mail managing function integrately managing the electronic mail based on the status of the electronic mail corresponding to each terminal, as per teaching of Horiuchi, because it improves the telephone capable of retaining the electronic mail when the user has not yet read the electronic mail properly.

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Regarding claim 3, Horiuchi teaches a process table for storing a process to be applied to the electronic mail after the electronic mail is downloaded to each of the terminal devices (figure 7 and col. 5 lines 13-16).

Regarding claim 4, Horiuchi teaches the process to be applied to the electronic mail including deleting the electronic mail and keeping the electronic mail (col. 5 lines 48-56).

Regarding claim 5, Horiuchi teaches emergency process means (105) for judging whether or not a priority is necessary based on the electronic mail received from each of the terminal devices (col. 6 lines 5-18).

Regarding claim 6, Horiuchi teaches an identifier memory for storing an identifier of a terminal device to be connected, and permitting an access from the terminal device in case that the identifier coincides with the stored identifier (col. 4 lines 24-30).

Regarding claim 7, Hsiao teaches a mail managing method in a mail managing apparatus as shown in figure 1 capable of transmitting and receiving mail data to and from at least a mail server and a terminal device, the method comprising a reading process of reading mail which is sent to a user stored in the mail server (col. 4 lines 3-4 and lines 43-45), a storing process of storing the mail read in the reading process (col. 4 lines 5-8), a display process of displaying a status of the mail stored in the storing process for the terminal device (figure 3), and a transmitting process of transmitting the mail stored in the storing process to the terminal device (col. 4 lines 17-19), wherein the electronic mail managing function is provided logically between the mail server and the computer (col. 5 lines 26-35 and col. 7 lines 6-15). Hsiao differs from the claimed invention in not specifically teaching that the status including whether or not the electronic mail is downloaded to each of the terminal devices in order to manage the electronic mail based in the status of the electronic mail corresponding to each of the terminal devices. However, Horiuchi teaches transmitter and receiver (101 and 103) for an electronic mail system capable of connecting with a plurality of terminals (figure 1 and col. 2 line 62 through col. 3 line

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29) comprising a status memory (405) for storing each status of the electronic mail as shown in figure 7 and a mail managing function integrately managing the electronic mail based on the status of the electronic mail corresponding to each of the terminal (col. 5 lines 12-67). By combining Hsiao with Horiuchi, the electronic mail will retain in the memory if a user hasn't read the mail properly. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Hsiao in having the electronic mail managing function integrately managing the electronic mail based on the status of the electronic mail corresponding to each terminal, as per teaching of Horiuchi, because it improves the telephone capable of retaining the electronic mail when the user has not yet read the electronic mail properly.

Regarding claims 8-9, the limitations of the claims are rejected as the same reasons set forth in claim 7.

Regarding claim 12, Horiuchi teaches process specifying means for specifying how the electronic mail transmitted to the terminal device should be process for each terminal device (col. 3 lines 30-49).

Regarding claim 13, Hsiao teaches the electronic mail apparatus further comprising means for receiving the electronic mail from each terminal device and means for transmitting the received electronic mail to the mail server (col. 5 lines 17-25).

Regarding claim 14, the limitations of the claim are rejected as the same reasons set forth in claim 5.

Regarding claim 15, the limitations of the claim are rejected as the same reasons set forth in claim 6.

Regarding claim 16, Hsiao teaches the electronic mail managing apparatus provided in a telephone (figure 1).

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Regarding claims 17, 24 and 31, the limitations of the claims are rejected as the same reasons set forth in claim 9.

Regarding claims 20, 27 and 34, the limitations of the claims are rejected as the same reasons set forth in claim 12.

Regarding claims 21, 28 and 35, the limitations of the claims are rejected as the same reasons set forth in claim 13.

Regarding claims 22, 29 and 36, the limitations of the claims are rejected as the same reasons set forth in claim 5.

Regarding claim 23, 30 and 37, the limitations of the claims are rejected as the same reasons set forth in claim 6.

Regarding claim 38, the limitations of the claim are rejected as the same reasons set forth in claim 16.

Response to Arguments

5. Applicant's arguments filed 3/28/2003 (paper no. 16) have been fully considered but they are not persuasive.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., storing each state of the electronic mail stored in the mail memory so as to correspond to each of the terminal devices, wherein each state stored in said status memory means indicates whether or not the electronic mail is downloaded to each of the terminal devices) are not recited in the rejected claim(s), i.e., claims 7, 8, 9, 17, 24 and 31. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). In addition, the claimed language of

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claims 9, 17, 24 and 31, are vague so that it is unclear whether “the terminal device” or “the associated terminal device” is referring to each terminal device or one of the plurality of terminal devices.

In response to applicant's argument that the state of the electronic mail of the references is different from the claimed invention, it appears that Horiuchi clearly teaches to generate a flag, i.e., the state of the electronic mail, stored in the memory means to indicate whether or not the electronic mail is normally transmitted to user terminal, and to manage the electronic mail, i.e., to delete the electronic mail, based on the state of the electronic mail (col. 5 lines 12-67). Note while the claimed invention does not specify the plurality of terminal devices are used by one user as described in the specification (page 11, lines 6-11). Thus, the combination of Hsiao and Horiuchi is enough to reject unduly broad claims 1, 3-9, 12-17, 20-24, 27-31 and 34-38.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Uchiumi (JP 61-101,140A) discloses a message managing system of mailbox to allow sender to grasp the reception state after mail transmission (abstract). Ota (JP 11-328062A) discloses an electronic mail device to display reply condition to realize an efficient reply processing (abstract).

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any response to this final action should be mailed to:

BOX AF

Commissioner of Patents and Trademarks

Washington D.C. 20231

Or faxed to:

(703) 872-9314 (for Technology Center 2600 only)

Hand delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, V.A., Sixth Floor (Receptionist).

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to George Eng whose telephone number is 703-308-9555. The examiner can normally be reached on Tuesday to Friday from 7:30 AM to 6:00 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Curtis A. Kuntz, can be reached on (703) 305-4870. The fax phone number for the organization where this application or proceeding is assigned is 703-308-6306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-0377.

A handwritten signature in cursive script that reads "George Eng".

George Eng

Examiner

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